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LIVERSEDGE, JENNIFER L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/899,260

Applicant(s)

HIGASHI ET AL.

Examiner

JENNIFER LIVERSEGE

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/899,260 filed on April 10, 2008.

The amendment contains previously presented claims: 9-14.

The amendment contains currently amended claims: 1-8.

The amendment contains new claim: 15.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is unclear with regards to steps of receiving data to be information-processed attached together with an amount of electronic money, and then the subsequent step of associating the data with the electronic money. It is unclear what additional elements are intended with the associating step given that the data was previously received as attached together.

Claim 2 refers to "the received electronic money" rather than "the received electronic money data" as was modified in the other independent claims. The previous 112 rejection stands with regards to this remaining claim language.

Claim 4 refers to "result of the electronic money validation" rather than "result of the electronic money data validation" as was modified in the other independent claims. The previous 112 rejection stands with regards to this remaining claim language.

Claim 15 includes in its final step an "if" statement in which the steps for only one resolution of the "if" statement is cited. For purposes of examination, examiner will assume the statement reads "when the received..." rather than "if the received...".

Claims 1-5, 8 and 15 contain the newly amended limitation that the electronic money data includes "validity information for determining whether the electronic money is valid". It is unclear what validity information is intended to be and/or what it is comprised of. For purposes of examination, examiner will assume that it is meant that information pertaining to the electronic money which indicates how it should be checked for validity is included.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,075,666 B1 to Aiyama (further referred to as Aiyama), and further in view of US Patent 6,938,154 B1 to Berson et al. (further referred to as Berson).

Regarding claim 1, Aiyama discloses an information processing and electronic payment method (columns 1-8) comprising the steps of:

Receiving, through a network, data including both processing data to be information-processed and electronic money data including an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

Making a request to determine whether the received electronic money data is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money data is confirmed to be valid, automatically starting the processing of the processing data to be information-processed (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the processing data and the electronic money data are attached together. However, Berson discloses wherein the processing data and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 2, Aiyama discloses an information processing method (columns 1-8) comprising the steps of:

Receiving, through a network, data to be information-processed and electronic money data including an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

Relating the received data to be information-processed with the electronic money data by which payment for information is made (Figure 4; column 6, lines 10-39; column 7, lines 1-8; column 8, lines 6-7);

Making a request to determine whether the received electronic money data is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money is confirmed to be valid, automatically starting the processing of the processing data to be information-processed (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money data are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are

inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 3, Aiyama discloses an electronic payment method (columns 1-8) comprising the steps of:

Receiving, through a network, data to be information-processed and electronic money data including an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that

validating the electronic money would also be performed as credit card validation is performed);

Associating the data with the electronic money data(Figure 4; column 6, lines 10-39; column 7, lines 1-5; column 8, lines 6-7);

Making a request to determine whether the received electronic money data is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money data is confirmed to be valid, automatically starting the processing of the processing data which is associated with the validated electronic money data (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money data are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the

mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 4, Aiyama discloses a system for making payment by electronic money (columns 1-8) comprising:

A user side subsystem including a user's terminal (Figures 1 and 4),

An electronic money issuer side subsystem including an electronic money issuing server (Figure 4), and

A processor side subsystem including a data processor that performs a processing based on processing request data from the user (Figures 1 and 4),

Wherein the user side subsystem, the electronic money issuer side subsystem and the processor side subsystem are connected to one another through a network (Figure 4),

Wherein the user side subsystem transmits both the processing request data and electronic money data including an amount of electronic money issued by the electronic money issuer side subsystem that is necessary for payment for processing of the processing request data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is

also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

The processor side subsystem transmits the electronic money data to the electronic money issuer side subsystem (column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7);

The electronic money issuer side system determines whether the electronic money data is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

The processor side subsystem performs the processing based on the processing request data in accordance with a result of the electronic money validation and transmits a request for payment for the processing to the electronic money issuer side subsystem (column 6, lines 10-67; column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money data are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would

be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claims 5-6, Aiyama discloses an electronic money processor (columns 1-8) comprising:

A receiving member which receives both processing request data transmitted from a user through a network and based on which a processing requested by the user is executed and electronic money data transmitted from the user through the network and including an amount of electronic money that is necessary for payment for processing said processing request data and issued by an electronic money issuer (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

A memory in which the processing request data received by the receiving member is stored (Figure 1; column 3, lines 52-61);

A transmitter which transmits the electronic money data received by the receiving member to the electronic money issuer to check whether the electronic money data is valid or not (Figure 4; column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7); and

An execution controller which controls execution of the processing based on the processing request data corresponding to the electronic money data and stored in the memory in accordance with a result of the check of validity of the electronic money data(column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money data are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by

Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 7, Aiyama discloses an image forming apparatus comprising the electronic money processor as claimed in claim 5 (see rejection to claim 5 above), further comprising:

An image forming portion in which execution of the processing is based on the control of the processing request data by the execution control means of the electronic money processor (column 7, lines 1-16).

Regarding claim 8, Aiyama discloses an image forming apparatus comprising:

A receiving member which receives both print data transmitted from a user through a network and electronic money data corresponding to the print data transmitted from the user through the network and including an amount of electronic money issued by an electronic money issuer that is necessary for payment for processing said print data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

A transmitter which transmits the electronic money data received by the receiving member to the electronic money issuer to check whether the electronic money data is valid or not (Figure 4; column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7); and

An image forming portion which processes the print data in accordance with a result of the check of validity of the electronic money data (column 7, lines 1-16).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money data are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money data are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the

electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claims 9-14, Aiyama does not specifically disclose wherein the processing data and electronic money are attached together in a data packet including header information and print control command. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together in a data packet including header information and print control command (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money in a data packet including header information and print control command as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 15, Aiyama discloses an information processing method (columns 1-8) comprising the steps of:

Receiving, through a network, job data including processing data to be information-processed and electronic money data including an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7) and validity information for determining whether the electronic money data is valid (column 7, lines 1-5 where a charge card number is received to determine if the presented form of payment is valid and column 8, lines 4-7 where electronic money is also collected for payment and it would be obvious that validating the electronic money would also be performed as credit card validation is performed);

Making a request to determine whether the electronic money data is valid (column 7, lines 1-5; column 8, lines 6-7); and

If the received electronic money data is confirmed to be valid, automatically starting the processing of the processing data to be information-processed (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not disclose separating processing data and the electronic money data. However, Berson discloses where processing data and electronic money data are received together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49

where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network) and wherein a portion of that data is decrypted for operation of the network device (column 2, lines 37-60; column 4, lines 26-49). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the separation of the processing information and the electronic money data as disclosed by Berson with the processing of information processing data and validation of payment by electronic payment as disclosed by Aiyama. The motivation would be that though the data are received together, different portions of the data require different validation methods and therefore need to be separated to accommodate the validation.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection. The added limitation regarding the inclusion of validity information has been addressed in the rejection above, in light of the 112 rejection surrounding the unclear and indefinite language.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692